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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD BRYAN SAGAR

Appeal 2008-005418
Application 09/780,229
Technology Center 2100

Decided: August 31, 2009

Before JEAN R. HOMERE, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-16. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm in part.

Invention

Appellant's invention relates to electronic devices and their user interfaces. More particularly, the present invention relates to a user-interface suitable for portable electronic devices. (Spec. 1, ll. 6-8).

Claim 1 is illustrative:

1. A data processing apparatus having a user interface assisting in searching for information from an ordered list in a data array, the apparatus comprising:

an array scroller responsive to user actuation; and

a helper character-generator, actuated by continued user actuation of the array scroller, the helper character generator being operative to display a helper character representative of a searching position in the list and of at least some of the information corresponding to the searching position.

Prior Art

The Examiner relies on the following references as evidence:

Mugura	US 5,977,975	Nov. 2, 1999
Little	US 6,204,846 B1	Mar. 20, 2001
Gibb	US 6,225,996 B1	May 1, 2001
Xia	US 6,252,594 B1	June 26, 2001

Examiner's Rejections

- I. Claims 1-3, 8-14, and 16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Little.

II. Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Little in view of Mugura.

III. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Little in view of Gibb.

IV. Claims 7 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Little in view of Xia.

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Brief and the Answer for their respective details.

FINDINGS OF FACT

In our analysis *infra*, we rely on the following findings of fact (FF):

1. Little discloses a popup window 156 *that may be displayed in response to initiation of a drag event while the pointer is disposed over slider control 142 of the display representation 140.* (Col. 9, ll. 30-34).

2. Independent claim 16 recites *an array scroller adapted to scroll the information at a speed that is responsive to user actuation*, which is not recited in claim 1, and is not addressed by the Examiner in the Answer.

APPELLANT'S CONTENTIONS

1. Appellant contends that Little fails to teach a “helper character that represents both the current searching position being viewed in an ordered list as well as some of the information, i.e., content, of that portion of the list.” (App. Br. 5; *see* claims 1-3 and 8-14, as grouped together by Appellant on page 3 of the Brief).

2. Appellant contends the Examiner did not provide a prima facie case of anticipation with respect to claim 16, which recites different features than claim 1. (App. Br. 6-7).

3. Appellant contends the Examiner did not provide a prima facie case of obviousness for dependent claims 4-7 and 15. (App. Br. 6-7).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Has Appellant shown the Examiner erred in determining that Little discloses a “helper character,” as claimed? (*See* claims 1-3 and 8-14, as grouped together by Appellant on page 3 of the Brief).

2. Has Appellant shown the Examiner erred in determining that Little discloses *an array scroller adapted to scroll the information at a speed that is responsive to user actuation*, as recited in independent claim 16?

3. Has Appellant shown the Examiner erred in concluding that dependent claims 4-7 and 15 are obvious under § 103?

PRINCIPLES OF LAW

Anticipation

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Obviousness

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellant’s Brief to show error in the Examiner’s proffered prima facie case.

ANALYSIS

Issue 1

§ 102 rejection of claims 1-3, 8-14, and 16

We decide the question of whether Appellant has shown the Examiner erred in finding that Little discloses the argued limitation of a helper character representative of a searching position in the list and of at least some of the information corresponding to the searching position. (*See* representative claim 1)

We note that the claimed “helper character” is not positively recited in the claim as being used to perform any machine-implemented function. Thus, Appellant’s argument (urging patentability based on what the “helper character” represents to a user) rests on nonfunctional descriptive material. The content of nonfunctional descriptive material is not entitled to weight in the patentability analysis. *Cf. In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir.

1994) (“Lowry does not claim merely the information content of a memory. . . . Nor does he seek to patent the content of information resident in a database.”). *See also Ex parte Nehls* (BPAI Jan. 28, 2008), available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071823.pdf>; *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (nonprecedential) (Fed. Cir. Appeal No. 2006-1003, *aff’d* Rule 36 Jun. 12, 2006); Manual of Patent Examining Procedure (MPEP) § 2106.01 (Eighth ed., Rev. 7, July 2008).

Because we conclude the recited “helper character” is nonfunctional descriptive material, we accord no patentable weight to the information content of the “helper character” (i.e., what the helper character represents to the human user). We broadly but reasonably construe the claimed “helper character” as a visible symbol that merely represents information. Thus, in light of our analysis and claim construction, we agree with the Examiner’s determination that the recited helper character is disclosed by Little (See Ans. 8-9 and FF 1).

Based on the above, we find that Appellant has not shown the Examiner erred in rejecting representative claim 1. Because Appellant has grouped claims 1-3 and 8-14 together in the Brief (p. 3), we sustain the Examiner’s anticipation rejection of claim 1, as well as the anticipation rejection of claims 2-3 and 8-14 which fall therewith.

Issue 2

§ 102 rejection of independent claim 16

We do however agree with Appellant's separate arguments regarding claim 16. (App. Br. 6-7). We note that the Examiner merely states in the rejection that claim 16 is rejected with the same rationale as claim 1 (Ans. 6). However, as pointed out by Appellant, claim 16 recites additional features (i.e., *an array scroller adapted to scroll the information at a speed that is responsive to user actuation*) that are not recited in claim 1, and these additional features have not been addressed by the Examiner in the rejection itself, or in the "Response to Arguments" section of the Answer. (FF 2). Thus, based on the record before us, we find Appellant has shown error in the Examiner's rejection of claim 16. Accordingly, we reverse the Examiner's anticipation rejection of claim 16.

Issue 3

§ 103 rejection of dependent claims 4, 6, 7, and 15

Appellant urges the patentability of these claims based on what the "helper character" represents to a user. (App. Br. 7, ¶ 2). We find this argument unavailing for the same reasons discussed *supra* regarding claim 1. Appellant's remaining arguments merely assert that the Examiner has failed to identify how the proposed modifications would correspond to the claimed invention. (App. Br. 7). Specifically, in the Brief, Appellant does not make any substantive arguments to distinguish the limitations of claims 4, 6, 7, and 15 from the portions of the cited references that were relied on in the

Examiner's rejections of these claims. (App. Br. 7). Instead, Appellant presents a series of conclusory arguments without citations to any specific portions of the references to provide the requisite evidentiary support.

Therefore, we are not persuaded of error in the Examiner's obviousness rejections of claims 4, 6, 7, and 15. We sustain the Examiner's § 103 rejections of claims 4, 6, 7, and 15 over the cited references of record.

§ 103 rejection of claim 5

Regarding dependent claim 5, we note that Appellant has not addressed the Examiner's new grounds of rejection for claim 5 (Ans. 8) by filing a responsive Reply Brief. (Ans. 8). Therefore, we *pro forma* sustain the Examiner's obviousness rejection of claim 5.

CONCLUSIONS

Appellant has not shown the Examiner erred in finding that Little discloses a "helper character," as claimed. See claims 1-3 and 8-14, as grouped together by Appellant on page 3 of the Brief.

Appellant has shown the Examiner erred in finding that Little discloses *an array scroller adapted to scroll the information at a speed that is responsive to user actuation*, as recited in independent claim 16.

Appellant has not shown the Examiner erred in rejecting claims 4-7 and 15 as being obvious over the cited references.

DECISION

We affirm the Examiner's rejection of claims 1-3, and 8-14 under 35 U.S.C. § 102(e).

We reverse the Examiner's rejection of claim 16 under 35 U.S.C. § 102(e).

We affirm the Examiner's rejections of claims 4-7 and 15 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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